

REMARKS

Claims 1-8 have been examined. With this amendment, Applicants cancel claim 5 and add claims 9-15. Claims 1-4 and 6-15 are all the claims pending in the application.

I. Formalities

Applicants thank the Examiner for initialing the references listed on form PTO/SB/08 submitted with the Information Disclosure Statement filed on August 10, 2004.

II. Claim Rejections - 35 U.S.C. § 103

- 1) The Examiner has rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Endo *et al.* (US 5,645,496) [“Endo”].
- 2) The Examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Tsunoda *et al.* (US 2002/0183135) [“Tsunoda”].

For at least the following reason, Applicants traverse the rejections.

Applicants have incorporated the allowed subject matter of claim 5 into claim 1 and have canceled claim 5. Applicants submit that claims 1-4 and 6-8 are allowable.

II. Allowable Subject Matter

Applicants thank the Examiner for finding allowable subject matter in claims 5-8 and for indicating that these claims would be allowable if rewritten in independent form. Applicants have incorporated the subject matter of claim 5 into claim 1 and have canceled claim 5.

III. New Claims

With this amendment, Applicants add claims 9-15. Applicants are submitting a declaration by Mr. Watanabe, one of the inventors, in support of the arguments given below for the patentability of the newly added claims.

With respect to independent claim 9, Applicants submit that Endo does not disclose a cover resin composition having a melt flow rate (MFR) of at least 3. In the attached declaration, the Mr. Watanabe states that the cover's melt flow rate in the cover composition of Hi-milan 1605 and 1706 (50/50) is 1.7, which is sufficiently smaller than the claimed range. Thus, Endo teaches away from the claimed cover's melt flow rate and the feature thereof.

Applicants also submit that the claimed MFR range is patentably different than Endo's disclosed range. The golf ball in Endo is similar to Comparative Example 2 of the present specification (see Tables 2 and 3) because the melt flow rate of Comparative Example 2 is 2.1. As a result, the cover resin composition would be poor in flow and is difficult to mold into a cover. In addition, because Endo's melt flow rate is close to that of Comparative Example 2, the cover is less durable to repeated impact.

Further, Endo does not disclose or suggest that the "core is formed of a rubber composition containing polybutadiene synthesized with a rare-earth catalyst as base rubber," as set forth in claim 9. Specifically, the cited reference fails to disclose that the polybutadiene is synthesized with a rare-earth catalyst. Applicants submit that being synthesized with a rare-earth catalyst brings about good resilience of the entire ball (as described in the present specification). Thus, the flight effects of the golf balls would differ between the present invention and Endo's golf ball. Therefore, Endo teaches away from the present invention and the effects thereof.

Tsunoda does not disclose or suggest a cover resin composition having a melt flow rate (MFR) of at least 3, and Tsunoda is silent on a core containing polybutadiene synthesized with a rare-earth catalyst. In the Examples of Table 2, Tsunoda discloses that the trade name of polybutadiene is "BR01," which is synthesized with Ni catalyst (i.e. not a rare-earth catalyst). Thus, Tsunoda does not suggest that the polybutadiene is synthesized with a rare-earth catalyst.

Claim 10 recites that the cover has "a Shore D hardness of 59 to 61." The Examiner cites the cover composition of Hi-milan 1605 and 1706 (50/50) in Endo as allegedly corresponding to the claimed cover. However, Watanabe et al. (US 6,592,471 B1) discloses that the resin hardness of Hi-milan 1605 and 1706 (50/50) is 63 in Shore D (the pertinent parts of Watanabe et al. are enclosed for the Examiner's convenience). Thus, Applicants submit that the resin hardness of the cover composition of Endo is 63, which is outside of the claimed cover hardness range (i.e. Shore D hardness of 59 to 61). Accordingly, Endo does not disclose the claimed element.

Accordingly, Applicants submit that independent claims 9 and 10 are patentable over the cited references for at least the reasons given above. Applicants also submit that dependent claims 11-15 are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

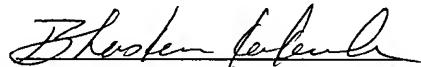
**Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 10/823,799**

Attorney Docket No.: Q81063

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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